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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/804,985	03/22/2004	Jack A. Parise	451590	8944
27717	7590	08/29/2007		
SEYFARTH SHAW LLP 131 S. DEARBORN ST., SUITE2400 CHICAGO, IL 60603-5803			EXAMINER HANSEN, JAMES ORVILLE	
			ART UNIT 3637	PAPER NUMBER
			MAIL DATE 08/29/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/804,985	Applicant(s) PARISE ET AL.	
	Examiner James O. Hansen	Art Unit 3637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-20,23,24 and 26-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-20,23,24 and 26-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 17-20, 23, 24 & 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kadlecek et al., [U.S. Patent No. 5,443,311] in view of British publication 477,158 [known hereafter as GB`158] and further in view of Boesvert [U.S. Patent No. 5,245,801]. Kadlecek (figures 1-6) teaches the use of a tool cabinet (11) for securing tools, and a locker (45) suspended on and connected with the tool cabinet, the locker having an interior space in which objects (drawers for example) may be moved into and out of, and a side opening (opening for drawers) for providing access into the interior space. A tool may be associated with the object and the object may be moved into and out of the space as readily apparent to the examiner. Kadlecek teaches applicant's inventive steps as disclosed above, including providing rollers (17) on the cabinet; but Kadlecek does not show the locker as being an "open bottom" cart having a lockable door. GB`158 (figures 1-2) is cited as an evidence reference to show the known use of a locker having an open bottom, a doorway, doors for closing the doorway and a cart to be moved in and out of the locker (note figures). Accordingly, the position is taken that it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the suspended locker of Kadlecek with the open bottom locker including the movable cart of GB`158 since this locker substitution would enhance the versatility of Kadlecek's tool cabinet assembly since

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the addition of the cart within the open bottomed locker would increase functionality of the assembly due to the carts ability to be moved both as a unit with the cabinet and locker and individually depending upon the needs or application of the user. As to claim 20, the locker further includes a retractable shelf (broadly viewed as the bottom of 13 for example) and a storing device (broadly viewed as the side frame members of 13 for example) on the shelf, wherein the shelf with the device can be retracted when the doors are open. As to the step of placing tools from the cabinet onto the cart, a tool (fig. 2) associated with the cabinet may be placed onto the cart of the modified assembly, wherein the cart may be either moved outside of the locker or housed in the interior space of the locker depending upon the needs or application of the assembly as dictated by the user. Since the tools are not functionally related in a new or unobvious way with regards to the assembly upon which they are associated, the step of placing a tool onto the cart from the cabinet will not distinguish the invention from the prior art in terms of patentability. As to a lockable door, Kadlecsek in view of GB`158 teaches applicant's inventive steps as noted above, but do not show a lock on a door for locking and unlocking purposes. Boesvert (figures 1-7) teaches the use of lock (fig. 5) for locking together doors of an open-bottom locker that encloses a cart (fig. 4). As such, the position is taken that it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate a lock to the prior art's assembly as taught by Boesvert because this arrangement would provide a means of restricting access to the cart to all but the authorized user when the cart is placed within the locker and the lock activated.

3. Claims 26 & 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kadlecsek et al., in view of GB`158 and Boesvert, and further in view of Materna [U.S.

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Design 306,373]. The combined prior art teaches a means for securing tools removed from a lockable cabinet and placed on a rolling cart as claimed by applicant, but Kadlecek does not specifically show the means by which the locker is attached to the cabinet. Materna (figures 1-12) is cited as an evidence reference to show that it was known in the toolbox art to suspend a locker (fig. 2) from the side wall of a movable tool cabinet (fig. 1) via a hook-shaped flange (see top section of fig. 2) and as to claim 26, inherent fasteners capable of extending through openings in the side wall of the cabinet (note the openings at the bottom section of fig. 2 – that accept a fastener to secure the bottom section of fig. 2 to a side wall of the cabinet (fig. 1), and as to claim 30, fasteners (middle section of fig. 2) are extended through openings in a wall of the locker that secure the bracket to the locket which is secured to the wall of the cabinet thus securing the locker to the cabinet. Accordingly, the position is taken that it would have been obvious to one of ordinary skill in the art at the time the invention was made to secure a locker to the cabinet of Kadlecek in view of Materna's teaching of such an assembly since this arrangement would securely seat a suspended locker to the side wall of the cabinet thereby forming a solid interconnected cabinet assembly. As previously stated, since the step of placing tools onto the cart is not functionally related in a new or unobvious way with regards to the assembly upon which they are associated, the step of placing a tool onto the cart from the cabinet will not distinguish the invention from the prior art in terms of patentability.

Response to Arguments

4. Applicant's arguments filed June 25, 2007 have been fully considered but they are not persuasive.

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5. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

6. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the position is maintained that one of ordinary skill in the art would exercise ordinary creativity, common sense and logic when viewing the prior art as a whole. Kadlecek was merely deficient in the aspects concerning its suspended locker i.e., having an open bottom, a lock on the door and a movable cart. GB'158 taught the known use of an open bottomed locker having a closure means for securing a movable cart within the locker. The position is taken that the simple substitution of one known element [locker with drawers] for another [open bottom locker with cart] would yield predictable results as to the combination. Furthermore, the application of Boesvert [the known application of a lock to a door] to the combined assembly would provide an improvement to the assembly that would also yield predictable results.

7. In response to applicant's arguments that "all the limitations must be taught or suggested by the prior art" note the following: The Supreme Court Decision *KSR*

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International Co. v. Teleflex Inc., 550 U.S.-, 82 USPQ2d 1385 (2007) forecloses the argument that a specific teaching, suggestion, or motivation be required to support a finding of obviousness, note *Ex parte Smith*, --USPQ2d--, slip op. at 20, (Bd. Pat. & Interf. June 25, 2007) {citing KSR, 82 USPQ2d at 1396}.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. *Remington et al.*, describes a tool storage and transport cart.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James O. Hansen whose telephone number is 571-272-6866. The examiner can normally be reached on Monday-Friday between 8-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 571-272-6867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



James O. Hansen
Primary Examiner
Art Unit 3637

JOH
August 24, 2007